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• **Comments:**

In re Application of: HÖSSEL et al.

Serial No.: 09/771,595

Filing Date: January 30, 2001

Attachments: Reply Brief under 37 C.F.R. §41.41

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION		ATTY. DOCKET:	PF51186
OF:	HOSSEL ET AL.	CONFIRMATION NO.:	8957
SERIAL NO.	09/771,595	GROUP ART UNIT:	1616
FILED:	JANUARY 30, 2001	EXAMINER:	MARINA LAMM

FOR: COSMETIC OR DERMATOLOGICAL SUNSCREEN PREPARATIONS

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REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

The following remarks are respectfully submitted in reply to the Examiner's Answer dated April 19, 2006.

REMARKS

Appellants' stand by the position taken in their main Brief on Appeal. It is noted that the Examiner has essentially merely reiterated her original position. This position is, however, deemed to be in error as explained in the arguments of the main Brief on Appeal.

It is noted also that the Examiner criticized that appellants had argued the references individually and not their combination, pointing out that non-obviousness cannot be shown by attacking ref-

erences individually where the rejection is based on a combination of references.[1] It is well settled that the motivation to modify or to combine references has to flow from some teaching or suggestion of the prior art.[2]

Also, the requirement of Section 103(a) "at the time the invention was made" is to avoid impermissible hindsight. "It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art."[3] Moreover, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.[4] The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination,[5] and citing references which merely indicated that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious,[6] absent evidence of a motivating force which would impel persons skilled in the art to do what the applicant has done.

To the extent that appellants addressed the references separately in the Brief on Appeal, the respective analysis was provided to specify what the respective reference, considered as a hole, reasonably conveyed to a person of ordinary skill in the art at the time appellants made their invention, and to determine whether the objective teaching of the references provided the motivation or suggestion which was necessary to select certain elements from the references and to combine them in such a manner as to arrive at the elements and the combination thereof which is set forth in appellants claims. In light of the necessity to evaluate the art "at the time the invention was made," appellants respectfully disagree with the Examiner's position that the respective remarks are "attacking the references individually" as the Examiner would have it. The criticism expressed by the Examiner in the Examiner's Answer is therefore not deemed to be justified.

In light of the foregoing and the reasons already presented in the main Brief on Appeal, appellants therefore respectfully maintain their request that the Examiner's decision be reversed. Favorable action is solicited.

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1) Cf. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2) See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

3) *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

4) *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, ibid.

5) *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *Berghauser v. Dann*, Comr. Pats. 204 USPQ 393 (DCDC 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

6) *Ex parte Hiyamizu* 10 USPQ2d 1393 (BPAI 1988).

Serial No. 09/771,595 HÖSSEL et al. PF 0000051186

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Respectfully submitted,
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